

Remarks

Claims 89-182 were pending in the subject application. By way of this amendment, claims 121-137 and 150 have been amended and claims 1-120, 138, 139, 142-149, 151-164, and 167-182 have been canceled. Thus, claims 121-137, 140, 141, 150, 165, and 166 are before the Examiner for consideration. The undersigned avers that no new matter is introduced by this amendment and that support for the newly presented claims can be found in the application and claims as originally filed. Accordingly, entry and consideration of the amendments presented herein is respectfully requested. Favorable consideration of the pending claims is also respectfully requested.

As an initial matter, the Examiner has objected to the subject specification on the grounds that it fails to comply with the requirements of 37 C.F.R. 1.821(a)(1) and (a)(2) regarding Figures 7A-7D. Applicants have amended the specification to indicate that the relationship between the sequences of the Figure and those provided in the Sequence Listing (e.g., SEQ ID NOs: 14-22). Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

The Office Action has objected to the specification under 35 U.S.C. § 132 on the basis that new matter has been introduced into the specification. In a previous Office Action, the Patent Office required the insertion of a description of SEQ ID NO: 12 and an indication of its relationship to SEQ ID NO: 1 in order to remove alleged confusion as to the two sequences. Pursuant to a request from the previous examiner in this matter, SEQ ID NO: 12 was originally presented to the Patent Office for the purposes of simplifying the search by indicating the appropriate symbols for nucleotides at various positions of SEQ ID NO: 1 that were to correspond to an elected invention. In order to clarify the current situation, Applicants submit herewith a Submission of Sequence Listing Under §1.821, including a replacement Sequence Listing on paper and in computer readable format, for the above-referenced patent application that indicates all the relevant features of SEQ ID NO: 12 (drawn from originally presented SEQ ID NO: 1). As also indicated in the Sequence Listing, SEQ ID NO: 12 contains appropriate symbols for the allele substitutions at nucleotide positions 402, 67092, 68525, 82234, and 82393. Applicants have also amended the Brief Description of the Sequences to attend to the new matter issue raised in the previous Office Action and believe that the issue has now been resolved. I hereby certify that the paper and computer readable copies contain the same information and that no new material is added by this submission. Entry and consideration of the

substitute Sequence Listing is respectfully requested. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested; however, the Examiner is respectfully requested to contact the undersigned should additional clarification of this issue be required.

Claims 121-141, 150-152, and 163-182 were rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a method of identifying a nucleotide (species position 67092 of the elected SEQ ID NO: 12) at a PCTA-1 biallelic marker (A30, allele T, p value = 0.033) in familial prostate cancer, biallelic marker combinations for familial cases of prostate cancer (Table 5; 26 combinations), and biallelic marker combinations for sporadic prostate cancer (Table 6; 18 combinations) does not reasonably provide enablement for the identification of other nucleotides at other PCTA-1 biallelic markers in familial prostate cancer (*i.e.*, A2, A41, *etc.*), sporadic prostate cancer (*i.e.*, A2, A30, *etc.*), or in all other combinations. In the interest of expediting prosecution, the claims have been amended and it is respectfully submitted that this issue is moot. Reconsideration and withdrawal of the objection is respectfully requested.

Claim 121, 131, 132, 133, 150, 151, 152, 167-172, 177, and 178, and all claims dependent therefrom, have been rejected because of the recitation "PCTA-1 related biallelic marker". It is respectfully submitted that the phrase is well-defined in the specification (for example, at page 11, lines 24-25); however, in the interest of expediting prosecution in this matter, Applicants have amended the claim to recite "a biallelic marker of SEQ ID NO: 12".

Claims 121, 140, 151, 167-172, 178, and all claims dependent therefrom have been rejected as being indefinite in the recitation of "the complement". The Office Action argues that it remains unclear as to the scope of the phrase "the complement". Applicants again respectfully traverse. As is clearly set forth in claim 121, the claim recites "or the complement of said nucleotide". In the context of the claim, it is respectfully submitted that one skilled in the art would recognize that the phrase is referring to a nucleotide found at a biallelic marker of SEQ ID NO: 12 as is recited within the claim. It is respectfully submitted that one skilled in the art would not have read the phrase to include the full length polynucleotide, rather the phrase would have been interpreted to include the complement of a biallelic nucleotide recited within the claim. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 150 was rejected as being indefinite as it was alleged that the claim language failed to recite a final process step that agreed back to the preamble. Applicants have amended the claim and respectfully request reconsideration and withdrawal of the rejection.

Claims 140-141 have been rejected as being indefinite in the recitation of the phrase “control population” as it is argued that the claim from which these claims depend lacks same recitation. While the record in the possession of the undersigned indicates proper antecedent basis for the phrase, Applicants respectfully submit that this issue is now moot as the claim from which claims 140-141 depend has now been re-written to attend to this issue. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing remarks and amendments to the claims, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants’ agreement with or acquiescence in the Examiner’s position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachment: New pages 1-212 (Sequence Listing)